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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,303	09/25/2000	Randy D. Sines	CA67-004	2747
21567	7590	03/12/2004	EXAMINER	
WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/669,303	SINES ET AL.	
	Examiner	Art Unit	
	Calvin L Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 14.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Status of Claims

1. Claims 1-31 have been examined.

Response to Amendments

2. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 13 and 26 recite a bank verifying or authenticating a customer transaction by variably selecting at least one of a set of verification or authentication variables to be used to verify or authenticate the transaction. This is not supported by the Specification. Specifically, the Applicant discloses a variable identifier such as a cookie (page 28, lines 17-21; page 44, lines 3-11), combining one or more verification analyses (page 38, 17-20; page 39, lines 1-3), or using one or more verification parameters (page 41, lines 14-18). However, this does not support “variably selecting” as there is no indication of the bank verification or authentication criteria changing, or *varying*, from transaction to transaction.

Claims 2-12, 14-25 and 27-31 are also rejected as they depend from claims 1, 13, and 26 respectively.

Claim 26 recites a buyer and seller conducting an electronic transaction where a buyer sends an order file to a merchant without sending a customer account number or identifier. However, in the Specification, page 56, the Applicant states that an order file includes a delivery address. If the delivery address is the same address that is associated on a customer’s account, then it can be used to identify the account. The Applicant also discloses, a customer providing a bank with PIN (Specification, page 64, lines 7-12). Therefore, the

Specification does not support the limitation regarding not communicating customer account identifiers.

Claims 27-31 are also rejected as they depend from claim 26.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the bank receiving verification variables.

Claims 1 and 13 contain the new limitation of performing a verification analysis using at least one verification variable. However, the claim only recites the bank receiving information *about* the verification variables but not the specific verification variables.

Claims 2-12 and 14-25 are also rejected as they depend from claims 1 and 13 respectively.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7 and 10-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bezos, U.S. Patent No. 5,727,163.

As per claims 1 and 6 , Bezos teaches a secure method of placing an order by internet or phone (figure 1; column 5, lines 10-34; column 6, lines 1-25) using a debit card (column 2, lines 49-55). In order to use a debit card, a user inherently has an account with a bank. Similarly, in order to have an account a user/debit card holder provides a bank with verification parameters such as address information, phone number and user identification. Therefore, the bank (selects and) uses at least one of the user provided user identification data in order to validate the transaction. Further, the bank detects each time a debit card is used to pay a merchant using the card and communicates computerized user identification information when the order is placed. Regarding “detecting”, this performed as funds (e.g. order information) needed to obtain goods and services

to be ordered, are drawn from a user bank account. Bezos also teaches a user communicating with a merchant site (abstract). Inherently, Bezos teaches communicating between a bank and a user to create an order file (record of the transaction) and communicating between the bank and the merchant to create a second order file based on the customer/user order file (e.g. authorization to use the card and verification of the desired amount to be drawn from a customer/user account).

As per claim 2, Bezos teaches using a debit card with computerized information, where the computerized information is a user id, computer id (e-mail) delivery address, and telephone caller identification (figure 2; column 6, lines 46-65; column 7, lines 9-16).

As per claims 3-5, Bezos teaches contacting a merchant internet site and building an order file (figure 2; column 6, lines 46-65; column 7, lines 9-16). Bezos also teaches a bank receiving at least part of the computerized [order] information (figure 2; column 2, lines 49-55), and merchant, user and bank in simultaneous communication as they are connected to each other via electronic network.

As per claims 7, and 10-12, Bezos teaches supplying customer verification information prior to obtaining order information (i.e. the user possesses a debit card) (column 2, lines 49-55) and using an alternative communications carrier to

supply at least some account verification information (e.g. voice, paper ... etc.- the plurality of methods used to open bank accounts).

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 13-20 and 23-31 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Walker et al., U.S. Patent No. 6,163,771.

As per claims 13-20 and 23-31, Walker et al. teach a method for purchasing goods and services by a customer comprising:

- creating a customer account prior (using an alternative communications carrier) to purchase that includes a plurality of different transaction verification parameters (figures 3A, 5, 11A-B and 13)
- communicating an order file to a merchant, communications between a customer and a bank concerning said order, verifying

said order using at least one verification parameter that is variably elected by the bank, communicating assurance of payment from bank to merchant using a transaction identifier, and the customer conducting the purchase (figures 3A-B, 5, 8-9B, 11A-B, 13)

- supplying customer account information over a network other than the internet (column 6, lines 14-29)
- customer, merchant and bank in simultaneous communication (figure 3A)
- communicating between the customer, merchant and bank to conduct a transaction without revealing a customer account number or identifier (figures 3A-B and 10-11B)
- a bank variably selecting a plurality of verification variables, that change for each transaction, to validate a transaction (figures 5, 9A-11B, and 13; column 11, lines 20-45; column 12, lines 8-45)
- a verification analysis that uses a weak link analysis and/or verification variables (figures 3A-B, 10-11B)

Walker et al. also teach an order file being created when the customer places an order (merchant order), another order file is created when the bank receives the debit or credit data pertaining to the order (bank customer order file), and the bank provides the merchant with an authorization assessment regarding the

customer credit or debit card data (second portion of the merchant order file based on the bank customer order file) (figures 3A-B and 8-11B).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos, U.S. Patent No. 5,727,163 in view of Harris et al., 6,014,635.

As per claims 8 and 9, Bezos teaches using a debit card to obtain goods and services (column 2, lines 49-55). As debit cards are tied to a user account, user identification information had to be supplied to the bank by the user in order to create the account. Harris et al. specifically recite a user creating a financial account via a 1-800 number (column 4, lines 55-67). Therefore, it would have been obvious to one of ordinary skill to allow users the convenience of creating an account over the phone.

13. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U.S. Patent No. 6,163,771 in view of Harris et al., 6,014,635.

As per claims 21 and 22, Walker et al. teach using a credit card to obtain goods and services (figures 5 and 13). As credit cards are tied to a user account, user identification information had to be supplied to the bank by the user in order to create the account. Harris et al. specifically recite a user creating a financial account via a 1-800 number (column 4, lines 55-67). Therefore, it would have been obvious to one of ordinary skill to allow users the convenience of creating an account over the phone.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

March 5, 2004

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600